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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,105	02/20/2004	Craig P. Lufbig	6445P001	6924
8791 7590 01/08/2009 BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP 1279 OAKMEAD PARKWAY SUNNYVALE, CA 94085-4040				
EXAMINER				
RAPILLO, KRISTINE K				
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/784,105

**Applicant(s)**

LUFTIG, CRAIG P.

**Examiner**

KRISTINE K. RAPILLO

**Art Unit**

3626

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6-7, 10-15, 17, 18, 21-26, 28, 29 and 32 is/are pending in the application.
- 4a) Of the above claim(s) 5, 8-9, 16, 19-20, 27, 30-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4, 6-7, 10-15, 17-18, 21-26, 28-29, 32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8 April 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-848)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 8/30/2004: 7/24/2006
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Notice to applicant***

1. This communication is in response to the amendment submitted October 2, 2008. Claims 1, 6, 7, 10 - 11, 17 - 18, 21 - 22, 28 - 29, and 32 are amended. Claims 5, 8 - 9, 16, 19 - 20, 27, and 30 - 31 are cancelled. Claims 1 - 4, 6 - 7, 10 - 15, 17 - 18, 21 - 26, 28 - 29, and 32 are presented for examination.
2. Please note: the application number is incorrect on the Amendment/Request for Reconsideration documents (pages 1 - 16). The incorrect application number documented is 10/748,105.

### ***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "110" and "120" have both been used to designate "member" and reference characters "114" and "121" have both been used to designate Employer. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

4. The disclosure is objected to because of the following informalities: Additions to the specification (paragraphs [0036], [0054] and [0079] were not underlined. Amendments to the specification, other than the claims, computer listings (37 CFR 1.96) and sequence listings (37 CFR 1.825), must be made by adding, deleting or replacing a paragraph, by replacing a section, or by a substitute specification. In order

Art Unit: 3626

to delete, replace or add a paragraph to the specification of an application, the amendment must unambiguously identify the paragraph to be modified either by paragraph number (see MPEP § 608.01), page and line, or any other unambiguous method and be accompanied by any replacement or new paragraph(s). Replacement paragraphs must include markings to show the changes. A separate clean version of any replacement paragraphs is not required. Any new paragraphs must be presented in clean form without any markings (i.e., underlining). See MPEP 714 [R-6], II, B. Appropriate correction is required.

5. The objection to the typographical errors is hereby withdrawn based upon the amendment submitted October 2, 2008.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1 - 4, 6 - 7, and 10 are rejected under 35 U.S.C. 101. because the claimed invention does not fall into one of the four statutory classes, namely, a process (or method); a machine; an article of manufacture; or, a composition or matter. Specifically, the claimed invention in claim 1 is directed to a computer program (module or software). Computer programs not claimed as embodied in a computer readable media are descriptive material and are not statutory because they are not capable of causing functional changes in the computer. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer which permit the computers program to be realized (see MPEP 2106, section IV, B, 1).

8. Claims 11 - 15, 17 - 18, and 21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In order for a method to be considered a "process" under 35 USC § 101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S.

Art Unit: 3626

53, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under 35 USC § 101 and is non-statutory subject matter. With regard to claim 1, the method claimed by the Applicant is not tied to another statutory class as it recites the limitations "creating a defined contribution application ...", "linking defined contribution plan information ....", and "establishing allocation rules ....". The method claimed does not include a particular machine, nor does it transform the data identifying the patient. The method steps recited in the body of claim 1 could reasonably be interpreted to encompass a human being performing these steps. Claims 12 – 15, 17 – 18, and 21 have similar deficiencies as noted above with regard to claim 1 and therefore are rejected for substantially the same reason.

The above deficiency can be overcome by expressly stating in the body of the claimed method, using a computer (apparatus) or terminal, for example, which makes the claim useful.

***Claim Rejections - 35 USC § 102***

9. The 35 USC § 102 rejections of claims 1 – 4 and 9 – 10 are hereby withdrawn based upon the amendment submitted October 2, 2008.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1 – 4, 6 – 7, 10 – 15, 17 – 18, 21 – 26, 28 – 29, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lencki et al., herein after Lencki (U.S. Publication Number 2002/0049617) in view of Kaehler et al. (U. S. Publication Number 2005/0086075 A1), hereinafter Kaehler.

Art Unit: 3626

In regard to claim 1 (Currently amended), Lencki teaches a system to integrate a defined contribution plan with a health plan comprising:

- a claim processing system (paragraph [0111]);
- a health plan management software module (paragraph [0281]) where Lencki discloses customer service software which can be modified to encompass a health care plan; and
- a defined contribution management software module integrated with the health plan management software module (paragraphs [0093] and [0094]), both the health plan management and defined contribution software modules operable by the claim processing system to:
  - create a defined contribution application for the health plan to allow for the entry of information for the defined contribution plan (paragraphs [0271] and [0273]),
  - link defined contribution plan information to the health plan (paragraph [0184]); and
  - establish allocation rules and amounts for the defined contribution plan (paragraph [0084]);
  - Allocation rules and amounts for the defined contribution plan which comprises for the FSA, defining parameters including a claim submission method considered during FSA claim processing (paragraphs [0081], [0193], and [0206] where Lencki discloses an invention in which an employee contributes to an account where pre and post tax dollars can be contributed, which is equated to a flexible spending account.

Lencki fails to teach a system comprising: the defined contribution plan being either a Health Reimbursement Arrangement (HRA) account or a Flexible Spending Account (FSA) account; which comprises, for the HRA, determining whether HRA allocated amounts are to be carried over.

Kaehler teaches a system comprising: the defined contribution plan being either a Health Reimbursement Arrangement (HRA) account or a Flexible Spending Account (FSA) account (paragraphs [0033] and [0052]) which comprises, for the HRA, determining whether HRA allocated amounts are to be carried over (paragraphs [0033] and [0052]).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a system comprising: the defined contribution plan being either a Health

Art Unit: 3626

Reimbursement Arrangement (HRA) account or a Flexible Spending Account (FSA) account (paragraphs [0033] and [0052]) which comprises, for the HRA, determining whether HRA allocated amounts are to be carried over (paragraphs [0033] and [0052]) as taught by Kaehler, within the system of Lencki, with the motivation of allowing a participant (i.e. employee) of a health plan to choose how their health care funds, by way of an HRA and/or FSA, are distributed (Kaehler: paragraph [0044]).

In regard to claim 2 (Original), Lencki and Kaehler teach the system of claim 1. Lencki further teaches a system comprising a claim processing defined contribution software module integrated with a health plan claim processing software module, both the health plan claim processing and defined contribution claim processing software modules operable by the claim processing system to: perform claim processing (paragraph [0111]; and determine a claim payment for a member based on the defined contribution plan (paragraph [0011]).

In regard to claim 3 (Original), Lencki and Kaehler teach the system of claim 1. Lencki further teaches a system wherein the health plan claim processing and defined contribution claim processing software modules store a record of a claim payment for the defined contribution plan for access by a member, provider, employer, broker or employee of the health plan (paragraphs [0134] and [0135]).

In regard to claim 4 (Original), Lencki and Kaehler teach the system of claim 3. Lencki further teaches a system comprising a network interface to couple the claim processing system to a network, wherein a member of the health plan utilizing a computing device accesses a record of a claim payment for the defined contribution plan through the network (paragraph [0196]).

In regard to claim 6 (Currently amended), Lencki and Kaehler teach the system of claim 1. Lencki further teaches a system wherein establishing allocation rules and amounts for the HRA comprises defining parameters including at least one of copays, deductibles, coinsurance, and patient

Art Unit: 3626

liability portions that are considered for payment by the HRA during claim processing (paragraphs [0181], [0193], and [0206]). Lencki fails to teach an HRA.

Kaehler teaches an HRA (paragraphs [0033] and [0052]).

The motivation to combine the teachings of Lencki and Kaehler is discussed in the rejection of claim 1, and incorporated herein.

In regard to claim 7 (Currently amended), Lencki and Kaehler teach the system of claim 1. Lencki further teaches a system wherein establishing allocation rules and amounts for the HRA comprises defining a member's allocation amount and tier (paragraph [0206]). Lencki fails to teach an HRA.

Kaehler teaches an HRA (paragraphs [0033] and [0052]).

The motivation to combine the teachings of Lencki and Kaehler is discussed in the rejection of claim 1, and incorporated herein.

In regard to claim 10 (Currently Amended), Lencki and Kaehler teach the system of claim 1. Lencki further teaches a system wherein establishing allocation rules and amounts for the FSA comprises defining parameters including an FSA allocation amount and that is considered during FSA claim processing (paragraphs [0081], [0193], and [0206]).

Method claims 11 – 15 and 21 repeat the subject matter of system claims 1 – 4 and 10 as a series of steps rather than a set of apparatus elements. As the underlying elements of claims 1 - 4 and 10 have been shown to be fully disclosed by the teaching of Lencki in the above rejection of claims 1— 4 and 10, it is readily apparent that the system disclosed by Lencki performs these steps. As such, these limitations (claims 11 – 15 and 21) are rejected for the same reasons given above for system claims 1— 4 and 10, and incorporated herein.



Method claims 17 – 18 repeat the subject matter of system claims 6 - 7 as a series of steps rather than a set of apparatus elements. As the underlying elements of claims 6 - 7 have been shown to be fully disclosed by the teachings of Lencki and Kaehler in the above rejection of claims 6 - 7, it is readily apparent that the system disclosed by Lencki and Kaehler performs these steps. As such, these limitations (claims 17 – 18) are rejected for the same reasons given above for system claims 6 - 7, and incorporated herein.

Machine-readable medium claims 22 - 26 and 32 repeat the subject matter of system claims 1 – 4 and 10 as the execution of a series of steps rather than a set of apparatus elements. As the underlying elements of claims 1 - 4 and 10 have been shown to be fully disclosed by the teaching of Lencki in the above rejection of claims 1— 4 and 10, it is readily apparent that the system disclosed by Lencki performs these steps. As such, these limitations (claims 22 - 26 and 32) are rejected for the same reasons given above for system claims 1— 4 and 10, and incorporated herein.

Machine-readable medium claims 28 - 29 repeat the subject matter of system claims 6 - 7 as the execution of a series of steps rather than a set of apparatus elements. As the underlying elements of claims 6 - 7 have been shown to be fully disclosed by the teachings of Lencki and Kaehler in the above rejection of claims 6 - 7, it is readily apparent that the system disclosed by Lencki and Kaehler performs these steps. As such, these limitations (claims 28 - 29) are rejected for the same reasons given above for system claims 6 - 7, and incorporated herein.

### ***Response to Arguments***

12. Applicant's arguments filed October 2, 2008 have been fully considered but they are not persuasive. Applicant's arguments will be addressed herein below in the order in which they appear in the response filed October 2, 2008.

13. In response to the Applicant's argument, it is respectfully submitted that the Examiner has applied new passages and new citations to the amended claims. The Examiner notes that the amended

Art Unit: 3626

limitations were not in the previously pending claims; as such, Applicant's remarks with the regard to the application of Lencki and Kaehler are addressed in the above Office Action.

***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTINE K. RAPILLO whose telephone number is (571)270-3325. The examiner can normally be reached on Monday to Thursday 6:30 am to 4 pm Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Luke Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KKR

/C Luke Gilligan/  
Supervisory Patent Examiner, Art Unit 3626